

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/698,648
Appeal No.: 2009-005792
Appellants: Steven L. Eaton, William E. Shannon III, Karen L. Karam & David O. DeRees
Filing Date: October 31, 2002
Title: Automated Realty Transfer

Art Unit: 3629
Examiner: Naresh Vig

Attorney Docket: LDC100A US

Request for Rehearing under 37 C.F.R. § 41.52

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant respectfully requests from the Board of Patent Appeals and Interferences (Board), a rehearing and reconsideration of the Board's affirmation of the Examiner's final rejection of Claims 1-6, 8-26, 28-46, and 48-60 under 35 USC §103(a) in the present appeal proceeding. Appellant acknowledges receipt of the decision of the Board mailed on February 22, 2010. By this request, Appellant desires to avoid a mere re-argument of Appellant's position on appeal and desires to narrow and simplify Appellant's arguments to facilitate the Board's reversal of the rejections. Therefore, Appellant herein states with particularity only the points of law and facts believed to have been misapprehended or overlooked in rendering the decision.

Nonetheless, Appellant hereby incorporates, by reference, the arguments previously submitted in Appellant's main brief on appeal filed March 17, 2008.

Appellant notes that the Board sustained the Examiner's final rejection of Appellant's Claims 1-6, 8-26, 28-46, and 48-60. These claims within the application were elected in response to an election requirement dated July 21, 2005. Claims 7, 27, 47, and 65-75 were withdrawn from consideration as drawn to non-elected subject matter.

Appellant asserts that Claims 1-6, 8-26, and 28-46 are not an obvious improvement over the teachings of Raveis, U.S. Patent Publication No. 2002-0049624 in view of the further teachings of Watanabe, Japanese Patent No. 2001-274946. Appellant respectfully asserts that the Board has erroneously mischaracterized the language in the body of Appellant's independent claims on appeal and misapprehended a point of law regarding a precise step in the relationships of the several steps disclosed and teachings thereof as set forth in Appellant's application.

Appellant recognizes, as set forth in the appeal decision at page 9 that obviousness is to be determined in terms of the level of skill of a person having ordinary skill in the art at the time the invention was made. 35 USC § 103; *Graham v. John Deere Co.*, 383 US1, 17-18, 148 USPQ 459, 467 (1966).

Accordingly, to establish a *prima facie* case of obviousness, the Patent Office must: (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a suggestion, inference, or implication to

make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941(Fed. Cir. 1992).

Appellant further recognizes that during prosecution proceedings, claims are to be given their broadest reasonable interpretation, consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

For purposes of brevity, the scope and content of the prior art are attached as Exhibit A and was taken from the appeal brief, pages 26-29, filed March 17, 2008.

Further, Appellants' invention is set forth in Exhibit B and was taken from the appeal brief, pages 30-31 filed March 17, 2008.

With respect to the first step in Appellants' independent claims, that is

"creating a real estate record on said at least one server."

The Board concluded at page 16 of the brief:

"...Thus, we find any field in the customer record to be equivalent to the record identifier as claimed by Appellant."

With respect to Appellants' next step of the independent claims, that is

"assigning a record identifier to the real estate record."

Here again, the Board concluded, at pages 16-17 of the brief, that

"since appellants' independent Claims 1, 21, and 41 do not require each real estate record to be assigned an identification number, but merely a unique record identifier which we interpret to be a field in the customer record, such as an address, which is unique (FF 7, 8). Thus, we find the combination of Raveis, Jr. and Watanabe makes obvious the step of assigning a record identifier to a real estate record, as generally recited by Appellants' Claims 1, 21, and 41."

With regard to Appellants' independent claims next step, that is

“receiving information from any fax source capable of contacting said at least one server irrespective of a fax number of said fax source.”

With respect to this step of Appellants’ claims, the Board concluded at page 17 of its brief:

“... we note that with regard to Appellants step of ‘receiving information from any fax source,’ performed prior to the ‘prompting step’ we interpret this step to be performed by a user entering the phone number into the fax machine.”

As stated hereinabove, Appellants desire to avoid a mere re-argument of Appellants’ position on appeal. So only for the purpose of this petition, the undersigned will accept the Board’s decision with respect to the first three steps of the claim and reserves the rights to appeal the Board’s decision with regard to these first three steps of the claim should further appeals be considered or necessary.

This petition specifically concerns the Board’s decision with respect to the next step of Appellants’ independent claims that is

“prompting a sender of information to input said record identifier into said fax source.”

With respect to this step, the Board’s findings state at page 17

“additionally, with regard to the prompting step, we find that a user is always prompted to initiate a fax transmission.”

Not only is this an erroneous finding but it is also completely inconsistent with the full, clear, and concise disclosure of the specification as set forth beginning at page 48, line 66 through page 51, line 3 regarding the faxing procedures and specifically page 48, lines 26-29 which state as follows:

“After dialing the central fax number, but prior to sending the fax, the person 70 is voice prompted to enter a mailbox number (aka the document routing number which was discussed previously above) by a procedure or fax manager software 78 that is loaded to one or more of the servers of the system of the present invention.”

This element step of the independent claim significantly simplifies the transmission of a fax document related to the real estate document management system claimed as the invention.

In the Watanabe prior art, a front cover page that is coded must be used to send a fax. The sender of a fax must somehow acquire the receiver ID for identifying receivers and make a cover sheet with the receiver ID on the cover sheet before said fax can be communicated to said receiver. Both Watanabe and Raveis are completely silent as to the identification of the receiver ID. For example, is it a name, address, mail box, phone, PDA, individual or what? For certain, we know it is not a record identifier of a real estate record. Only applicants invention discloses that information. Further, both Raveis and Watanabe are completely silent in their collective disclosure how or from whom a person desirous of sending a fax obtains this receiver ID. In the invention, either the documents to be faxed will contain such information or a simple phone call to the broker or buyer or seller will provide this information which is then keyed into the keyboard of the fax machine in response to the prompt for the record identifier.

This is the most important step of the claimed combination in independent Claims 1, 21, and 41, and is exemplified in the example that follows.

A person is in the process of buying a new house and hires an interior decorator to propose a unique window treatment for each window of the entire house. You as a buyer provide the interior decorator with the broker or agent's name and number and instruct the

decorator to make an appointment with either to view the home and thereafter fax a quotation to the automated real estate record system and obtain the record identifier from the agent or broker.

With these simple instructions, the interior decorator can provide a quotation to the buyer by accessing the fax server of the broker, entering the record identifier obtained from the broker's agent in response to the prompting step and thereby provide the buyer with a complete quotation for window treatments as per the buyer's request. This document can then be maintained in the document management system until the buyer accesses it to obtain a copy.

Since Raveis does not suggest, inform or imply the use of a fax, a person skilled in the art would have to recognize that Raveis disclosure could be improved by the use of Watanabe's fax techniques. It is nowhere suggested or implied in the prior art that the person skilled in the art would select or equate Watanabe's receiver ID to Appellants' unique record identifier especially in view of Watanabe's lack of disclosure with respect to what the receiver ID is. Even if we consider the Board's interpretation that any field of Raveis customer's record could be used. How does this person skilled in the art somehow pick Appellants' unique record identifier field with Raveis suggesting it could be any field as interpreted by the Board without the benefit of reading Appellants' disclosure. As clearly set forth in the Graham, *supra*, there must be some "suggestion, inference, or implication" to make the modifications of the references which would be necessary to arrive at the claim subject matter.

For the Board and Examiner to make such modification is easily accomplished since their interpretation of the claim language is made after having the benefit of reading Appellants' specification disclosure. The courts have long held that Monday morning quarterbacking is impermissible in a 35 USC § 103 analysis.

Appellant respectfully asserts that the Examiner as well as the Board is using hindsight reconstruction in an attempt to obviate Appellants' invention after having the benefit of reading Appellants' application. Absent recognition of the problem faced by the Appellants, the prior art cannot possibly suggest, singularly or in combination, a solution as novel as Appellants' invention. While the modifications that are made to the references to allegedly provide the subject invention may be relatively simple, once the advantages for making such changes are taught by Appellants' disclosure, such disclosure cannot be used against him in this regard. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1595, 1600 (Fed. Cir. 1988).

Further, the Examiner as well as the Board's suggested combination simply would not result in Appellants' invention. Assuming, arguendo, that it is possible to combine Raveis with Watanabe in an attempt to obviate Appellants' invention, it is clear from the teachings set forth in Raveis as well as Watanabe that the suggested combination would, at best, result in a document requiring a coded cover sheet in order to fax a document into the Raveis real estate document system. However, the combination would not result in Appellants' invention, since the combination would still require a cover sheet that needs to be coded with a receiver ID before a fax could be sent by a user. How or from whom this receiver ID is obtainable is a mystery because it is not suggested nor disclosed by Watanabe. Therefore, even if the combination as suggested by the Board or Examiner was legally justified, Appellants' claims would still have novel and unobvious physical features over the proposed prior art combination. The combination of the prior art references does not disclose all of the claimed features of

Appellants' invention and, therefore, the combination would necessarily constitute a different structure and obtain a different result than Appellants' claimed invention.

Accordingly, it is respectfully requested that for the reasons set forth above, that this honorable Board reconsider its position with respect to the rejection of Claims 1-6, 8-26, 28-46, and 48-60 as being obvious over the teachings of Raveis in view of the teachings of Watanabe.

Respectfully submitted,

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Certificate under 37 CFR §1.8(a)

I hereby certify that this correspondence is being electronically filed at the U.S. Patent Office in Alexandria, VA 22313-1450, via EFS filing on April 15, 2010.

Date: April 15, 2010

/Remy J. VanOphem/
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EXHIBIT A

Accordingly, to establish a *prima facie* case of obviousness, the Patent Office must: (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference, or implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992).

The mere fact that the prior art may be modified by the Examiner does not make the modification obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). In the present case, the Examiner has failed to make a proper *prima facie* showing of obviousness since the Examiner has failed to show how the prior art suggests the desirability of the proposed modification.

Scope and Content of the Prior Art and the Invention

Raveis, U.S. Patent Publication No. 2002/0049624 was cited by the Appellants upon the filing of their application, and is directed to the shortcomings of business models for real estate companies that fail to maintain customer relations and leave a homeowner trying to manage repairs and improvements with little more than a telephone book for assistance (¶ 0014).

To prevent these problems, Raveis teaches an improved system and method of using a distributed computer network to facilitate managing customer relationships and the information pertaining thereto in a real estate transaction (¶ 0016). In particular, the system and method provides for storing data relating to and coordinating the multitude of tasks associated with the

purchase or sale of a property from contract to close. The method includes the steps of generating a customer record including data entry fields for entering an estimated completion date and an actual completion date for each of a plurality of stages of a real estate transaction; providing a customer access to the customer record over a distributed computer network to facilitate the entry, by the customer, of estimated and actual completion dates for the stages of the real estate transaction (¶ 0018); providing a real estate agent access to the customer record over the distributed computer network to facilitate the entry, by the real estate agent, of estimated and actual completion dates for various stages of the real estate transaction (¶ 0018); providing a transaction coordinator access to the customer record through a server based application to facilitate the entry, by the transaction coordinator, of estimated and actual completion dates for stages of the real estate transaction in appropriate fields of the customer record (¶ 0018); indicating, in an appropriate field of the customer record, an identity of the entrant of an actual completion for a stage of the real estate transaction; and providing a hyperlink from the customer record to a site of a marketing partner associated with a stage of the real estate transaction (¶ 0018).

Raveis, Jr. further teaches a similar method to provide an entity access to the customer records, to facilitate entry, by the entity, of estimated and actual completion dates for stages of real estate transactions in appropriate fields of the customer record, wherein the entity is selected from the group consisting of a customer, real estate agent and transaction coordinator; and indicating, in an appropriate field of the customer record, the identity of the entity that entered an actual completion date for a stage of the real estate transaction (¶ 0019). Further, Raveis, Jr. teaches that the distributed computing network maybe the internet.

Raveis, Jr. further teaches that transaction tracking involves a series of activities or tasks related to the home sale or home purchase process. Schedules are developed to define a time table, track completed items and include related information, i.e. the transaction tracking process. These schedules are completely different for the home sale and home purchase process. The process of transaction tracking can be classified into distinct stages (¶ 0021). Customizable transaction tracking templates allow a combination of different stages to be included within each schedule. The stages included within the transaction process can be contingent upon a number of factors. Some of these factors include, but are not limited to, whether a transaction is a home sale or purchase, real estate practices within specific geographic areas, federal, state and local laws, or real estate broker preferences (¶ 0021).

In summary then, it is clear that Raveis, Jr.'s teachings are basically limited to providing access to a customer and a real estate agent to the customer record including fields for entering an estimated date and an actual completion date for each of a plurality of stages of the real estate transactions over the distributed computing network to facilitate entry estimated and actual completion dates for stages of real estate transactions.

Watanabe is directed to labor burdens and compromised conservation goals because a document to be faxed must first be printed out and then transmitted using a fax machine (6) to transmit the document to a destination fax machine (7). (Page 1, Summary; Fig. 5) As a solution to this problem, Watanabe teaches transmitting a special cover sheet having receiver ID information and being attached to the document to be faxed. In accordance with these teachings, Watanabe discloses an electronic filing method. First, a special cover sheet is set into an image scanner (30) (Fig. 1; Fig. 2, ST1; ¶ 0024). Second, image information on the special cover sheet

is acquired into an electronic terminal (23) (Fig. 1; Fig. 2, ST2; ¶ 0025). Third, a communications document (e.g. letter, etc) is imaged at the same time as the special cover sheet (Fig. 3, ST3; ¶ 0025). Fourth, a client using the electronic terminal outputs a transmission request to a fax server (30) (Fig. 1; Fig. 2, ST4; ¶ 0026). Fifth, a reply is received affirming acceptance of the transmission (Fig. 2, ST5; ¶ 0026). Sixth, image information from the special cover sheet is attached to the image information on the communications document, and then output to the fax server (Fig. 2, ST6; ¶ 0026). Seventh, the fax server transmits the image information to a DSP electronic filing device (12) (Fig. 1; Fig. 2, ST7; ¶ 0026). Eighth, the image information is received (Fig. 2, ST8; ¶ 0027) Ninth, the fax server executes a routine for decoding the receiver ID information scripted on the special cover sheet (Fig. 2, ST9; ¶ 0027). Tenth, the fax server specifies a document storage area for a receiver (client) at an electronic filing server (29) and stores the image information of the communications document in the document storage area (Fig. 1; Fig. 2, ST10; ¶ 0028). Eleventh, the fax server issues a reception notice to an electronic terminal (26) being operated by the receiver (client) (Fig. 1; Fig. 2, ST11; ¶ 0029).

Appellants' invention is directed to problems associated with a real estate transfer process which is typically accomplished through an assortment of communication mediums that are not integrated and often not in digital form. Also, in accomplishing this assortment of communications, realtors find themselves carrying out a variety of manual tasks, coordinating schedules of various parties involved in the process or personally delivering and dropping off documents to complete the process. Such traditional process requires a realtor to spend an inordinate amount of time actively managing mundane details, instead of spending time with

EXHIBIT B

more rewarding and value added responsibilities like counseling their clients, the marketing of properties, networking with other real estate professionals, and cross-selling real estate related services.

Numerous prior art real estate project managements offer packages that have been recently developed but present incomplete solutions, in that, they do not address all tasks within all phases of the real estate transfer process from prelisting to post-listing. Most available prior art technology do not provide a comprehensive approach to facilitating the handling of documents throughout the entire real estate transfer process according to existing real estate industry practices, wherein a real estate professional such as a broker, orchestrate all activities associated with the transfer.

Accordingly, Appellants teach automating the process of transforming real estate through the use of a centralized system and method for automating the process of transferring real estate. The invention is performed on one or more servers and is carried out over a distributed computer network that is connected between servers and a plurality of client computers. Appellants teach that a real estate record identity is created on the server and information is received thereon from a plurality of sources including real estate databases, computer input devices, facsimile equipment, electronic mail systems, and the like. The received information is then associated with the real estate record identity using a record identifier associated with the real estate record identity and thereafter the information is stored on the server according to the real estate record identity. In one embodiment of the present invention, the information is received by receiving a faxed communication from any fax source that is capable of contacting the server irrespective of the faxed number of the fax source. In other words, the server need not recognize a faxed

number of the fax source. More importantly, the invention includes server software that prompts a sender of the faxed communication to input the real estate record identity into the fax source.

This is accomplished by using the fax key pad which the user then uses to input the real estate record identity. Once the record identity is input by the fax sender it is recognized by the server, and the server software is capable of converting the faxed communication into a digital document directly that represents the information to be associated and stored. The server software then determines whether the input record identifier matches any of the number of real estate record identities that are stored on the server. If this determination is negative, then the digital document is discarded, but if it is positive, then the digital document is saved on the server and accord with its matching real estate record identity.

A similar process is used in receiving email communication associated with the real estate transfer. Accordingly, the system and method for automating real estate transfers is able to be controlled by a broker such that all communications associated with the real estate transfer can be stored in a real estate record identity on at least a server and carried over the distributed computer network to a plurality of client computers. The real estate broker can restrict third party participation in the real estate transfer, as well as establish calendar templates to be used by real estate agents, as well as limit the various parties associated with the real estate transfer to access the system so that these may actively participate in the automated transaction simply by using either a fax machine or direct access through the internet. As is clearly set forth, Appellants further teach in conjunction with the use of the real estate transfer system, a tiered security level for the various users of the real estate transfer process.